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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/691,261

**Applicant(s)**

GASTON ET AL.

**Examiner**

CANDICE D. CARTER

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/22/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The Following is a Second, Non-Final Office Action in response to communications received on August 1, 2008. Claims 1, 4, 6, 9, 11, and 14 have been amended. No claims have been cancelled. No new claims have been added. Therefore, claims 1-15 are pending and have been addressed below.

2.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**2. Claims 4, 9, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 4 recites the limitation "ABCD risk management scheme wherein an "A" is ascribed to a risk over which management can exercise much control, a "B" is ascribed to a risk which is mainly under control, a "C" is ascribed to a risk that is mainly outside control, and a "D" is ascribed to a risk that is out of control". Examiner is unsure what Applicant means by this limitation in the claim. The specification of this disclosure fails to provide a proper definition and/or explanation for an ABCD risk management scheme. Examiner cannot determine the scope of the claimed invention because of the use of the following relative claim language: much control, mainly under control, mainly outside control, under control, and out of control. Examiner asserts that the above

recitations are subjective, thereby, making it difficult to determine the differences between the classifications of risk. Appropriate clarification is required.

Claims 9 and 14 recite equivalent limitations to claim 4 and is, therefore, rejected using the same rationale as set forth above.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1-5 are directed towards a method for standardizing reporting of issues consisting of process steps that may be performed by a series of mental steps.

Examiner contends that a process must be (1) tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.

An applicant may show that a process claim satisfies 35 U.S.C. § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the

machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590. *In re Bilski*.

Neither of these requirements is met by these claims, therefore, these claims do not qualify as a statutory process.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Falso et al. (2003/0125965) in view of Wolff et al. (5,774,887).**

As per claim 1, Falso et al. discloses "A method for standardizing reporting of issues, assumptions, and risks for a risk review board, the method comprising:

presenting with a form for entering information about a risk management unit; receiving the information about the risk management unit" (¶ 27 and Fig. 2 disclose a display page used to collect information about a risk management contract, where the display page presents a form for entering the information);

"wherein the form provides the user with entry areas for every element needed to properly adhere to a risk management scheme" (Fig. 2 displays entry fields for elements needed for the risk management contract).

"wherein said entry areas for elements needed to properly adhere to a risk management scheme include at least a name of a risk owner, an explanation of how the risk came about, a driver of the risk, a milestone of the risk, the last possible start date for action to take place to avoid the impact of the risk, the criticality of the risk, the controllability of the risk, what actions have been taken to-date with respect to the risk, one or more actions that have been identified to prevent the risk from occurring, and the cost of any action" (§§ 34 and 35 disclose name fields and positions fields for identifying the name and organizational position of the person with responsibility for the selected contract, where the individual responsible for the contract is the individual that is responsible for the risks associated with the contract [risk owner])

Falso et al., however, fails to explicitly disclose "wherein the user is hindered from exiting the form prior to supplying all information necessary for adherence to the risk management scheme".

Wolff et al. discloses a customer service electronic form generating system "hindering the user from exiting the form prior to supplying all information" (col. 8, line 26-40 discloses that the system determines whether the form is complete before the user can exit from the existing form into the next uncompleted form).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method for managing contractual risk of Falso et al. to include the hindering of a user from exiting a form as taught by Wolff et al. in order ensure that a user has entered all pertinent information before exiting the form.

Furthermore, Examiner would like to note that limitations contained in wherein clauses are irrelevant as they are not positively claimed method steps.

Claims 6 and 11 recite equivalent limitations to claim 1 and are, therefore, rejected using the same art and rationale as set forth above.

As per claim 2, Falso et al. further discloses "generating a report in a standardized format based on the information about the risk" (§ 21 discloses generating a risk report which includes the information about the risk contract and Fig. 5 displays a sample risk report that is generated in a standardized format).

Claims 7 and 12 recite equivalent limitations to claim 2 and are, therefore, rejected using the same art and rationale as set forth above.

As per claim 3, Falso et al. discloses "the risk management unit is one of an assumption, a risk, an issue, and a risk plan" (§ 2 discloses a risk of not meeting a delivery deadline).

Claims 8 and 13 recite equivalent limitations to claim 3 and are, therefore, rejected using the same art and rationale as set forth above.

As per claim 4, as best understood, Falso et al. further discloses "the risk management scheme is an ABCD risk management scheme" (§ 19 discloses a system for managing risk factors, where this system is a risk management scheme).

Claims 9 and 14 recites equivalent limitations to claim 4 and are, therefore, rejected using the same art and rationale as set forth above.

As per claim 5, Falso et al. discloses all of the elements of the claimed invention but fails to explicitly disclose "the step of wherein the user is hindered from exiting the

form prior to supplying all information necessary for adherence to the risk management scheme comprises preventing the user from exiting an entry field until the user has provided an entry for the entry field".

Wolff et al. discloses a customer service electronic form generating system "preventing the user from exiting an entry field until the user has provided an entry for the entry field" (col. 9, line 37-47 discloses that the system determines whether the customer service representative has completed the current field before allowing the customer to move onto the next fields).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for managing contractual risk of Falso et al. to include the step of hindering a user from exiting a field before completing it as taught by Wolff et al. in order to ensure that a user has entered all pertinent information before exiting the field.

Claims 10 and 15 recite equivalent limitations to claim 5 and are, therefore, rejected using the same art and rationale as set forth above.

#### ***Response to Arguments***

5. Applicant's arguments filed August 1, 2008 have been fully considered but they are not persuasive.

In response to arguments in reference to claims 1, 6, and 11, Examiner asserts that the specific type of form is nonfunctional descriptive material as currently recited in the claim language. The specific type of form does not change the function of the claimed invention. Examiner contends that Wolff is fully capable of hindering a user



form exiting any type of form. Whether or not the form fields receives information pertaining to risks or tasks does not change how Wolff hinders a user from exiting the form before it is completed. Wolff verifies if the forms fields are filled and, if not, hinders the user from exiting. The specific information entered in the form fields does not matter.

In response to arguments in reference to claims 2-5, 7-10, and 12-15, all rejections made towards the dependent claims are maintained due to a lack of reply by the applicant in regards to distinctly and specifically pointing out the supposed errors in the examiner's prior office action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are unobvious and patentable over the prior art.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Scharmer (5,640,577) discloses a data processing system with automated at least partial forms completion). Mangin et al. (6,078,890) discloses a method and system for automated health care rate renewal and quality assessment. Wright, Jr. (5,704,029) discloses a system and method for completing an electronic form. Frankland et al. (2002/0026339) discloses an integrated change management unit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CANDICE D. CARTER whose telephone number is

(571) 270-5105. The examiner can normally be reached on Monday thru Thursday 7:30am- 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. D. C./  
Examiner, Art Unit 3629

/John G. Weiss/  
Supervisory Patent Examiner, Art Unit 3629